

Claim 3 shall be amended to replace the phrase "within said and" with the phrase "within said inner cavity."

Claim 5 shall be amended to replace the word "back" with the word "rear" this change should permit proper reference to the subject element.

Subsequent to the incorporation of the stated amendments the Petitioner respectfully requests that these rejections be withdrawn against Claims 3 -7.

CLAIM REJECTIONS – 35 USC § 102

The Petitioner acknowledges that the Examiner has rejected Claims 1 and 2 as being unpatentable under 35 USC § 102 (b) on the grounds of anticipation by Pullman (5,333,885) and Marsh (747,741), however notes that these rejections rest with the structure of the claimed invention and not the structure disclosed in the subject application. The Petitioner holds that Claims 1 and 2 are not anticipated by Pullman (5,333,885) and Marsh (747,741) as neither of these present each and every element of the invention. Citing Ortho -McNeil Pharmaceutical, Inc. v. Kali Laboratories, (N.J. 4-4-2007) pg. 54

Under 35 USC § 102 (b), a person is not entitled to a patent if the alleged invention was "described in a printed publication . . . more than one year prior to the date of the application." This standard is satisfied if two requirements are met. First, there must be "identity of the invention," or in other words, "each and every element as set forth in the claim [must be] found, either expressly or inherently described, in a single prior art reference." Constant v. Advanced Micro-Devices Inc., 848 F.2d 1560, 1570 (Fed. Cir. 1988). Second, the prior art reference must enable the person of skill in the art to make the invention. In Re Sasse, 629 F.2d 675, 681 (C.C.P.A. 1980). "[P]rior art references are presumed to be enabling." Id. Anticipation is a question of fact. In re McDaniel 293 F.3d 1379, 1382 (Fed. Cir. 2002).

In the instant case neither Pullman nor Marsh presents "hingable upper and lower panels that are capable of being raised and locked perpendicular to the nail salon." Further, Pullman is completely lacking of any such lower panel, which is an obvious element of the portable nail salon shown on FIGURES 1 and 2 of the present application further providing that the hingable panels abut so as to completely enclose the contents of the nail salon. The deficiency noted in the Pullman invention (*sans lower panel*) does not provide a means for securing the contents of

the structure by way of closing the upper and lower panels as does the nail salon. Further, the handle in Pullman is specifically designed to be detachable, as the handle receptacles located on the first and second body side panels are not meant to serve as handles, but exclusively as a means for receiving and retaining a tubular handle having an offset, which permitted its reversal for ease of transport of the cart. Claim 1 in the present application speaks to the right and left sides having a handle formed into the top of each side as an integral element, this clearly distinguishes from Pullman. The use of hindsight to address the shortcoming of this reference is impermissible and should be withdrawn as anticipation as invoked by 35 USC § 102 is not present. Citing Verdegaal Bros. v Union Oil Company of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed Cir, 1987)

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single art prior art reference."

In regard to Marsh, the upper panel is designed to extend vertically, not perpendicular to the box as noted in at line 37 of the 747,741 patent:

"... the box A is provided with a cover C, connected by hinges D to the back A² of the box, at the upper end thereof, and said cover C is adapted to be held in an open approximately vertical position by braces E, ..."

Upon review of the allowed claims in Marsh in light of the specification it is clear that the display is limited to a top cover that when locked open would be in a vertical position relative to the box. What is also notable is that if Marsh would open the top cover in a perpendicular manner (horizontal) to the box, it would be inoperable as it would not permit the display of magazines to the general public unless they were lying on the ground looking upward. This does not appear to be the intent embodied by Marsh. Such an arrangement would render the display box in Marsh inoperable (not enabled) and thus ineffective as a proper statutory prior art citation. Upon further inspection of Marsh, it is also noted that the feature of multiple shelves between the sides is notably absent. Accordingly, for the foregoing reasons this rejection must be withdrawn.

CLAIM REJECTIONS – 35 USC § 103

The Petitioner acknowledges that the Examiner has rejected Claims 2 and 3 as being unpatentable under 35 USC § 103 (a) on the grounds of obviousness by Pullman (5,333,885) in view of Marsh (747,741), however notes that these rejections rest with the structure of the claimed invention and not the structure disclosed in the subject application. The Petitioner denies that Pullman teaches the limitations of Claim 1 as Pullman lacks a lower hingable panel.

The combination of Marsh fails to yield a structure that is commensurate to the present invention in respect to either structure or function. The resultant would purport to be a portable box however the intent, purpose and function is lost in respect to Marsh, wherein the top cover must extend in other than a vertical fashion. Should the feature of a lower panel be incorporated in Pullman, the function of the cart is compromised as the addition of this feature would serve as an encumbrance to accessing and storage of items such as the bolt bucket shown in Pullman. This aspect as there is no suggestion in Pullman that such a feature is conducive, the contrary is true and the functionality of the cart is diminished as the purpose migrates from the intent in Pullman. This demonstrates that there exists no technological motivation for engaging in such a modification. The references are therefore not properly combinable as their intended function is destroyed. In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). The Petitioner respectfully requests that rejection of Claims 1 and 2 be accordingly withdrawn.

The Petitioner acknowledges that the Examiner has rejected Claims 3 and 4 as being unpatentable under 35 USC § 103 (a) on the grounds of obviousness by Marsh (747,741) in view of Fernandez (5,405,587), however notes that these rejections rest with the structure of the claimed invention and not the structure disclosed in the subject application. The Petitioner denies that Marsh teaches the limitations of Claims 1 and 2, as the upper panel in Marsh cannot achieve the perpendicular arrangement stated in Claim 2 without obviating the function of Marsh. The combination with Fernandez yields a cart that still fails to speak to the instant application by presenting a functional arrangement that is capable of a substantially similar function, citing In re Gordon. Given that Marsh cannot overcome its limitations of functional structure the combination of indentations as presented by Fernandez does not render Claim 4 obvious. Further, Fernandez expressly discloses holders for surgical instruments permanently affixed to the various surfaces of the sterilization cart; this is in contrast to the instant application wherein Claim 4 speaks to indentations. In addition the Petitioner challenges the motivation to combine these teachings as they would not be suggestive to persons of ordinary skill in the cosmetology arts to combine these references, citing In re Napier, 55 F.3d 610, 34 USPQ2d 1782 (Fed. Cir. 1995). The Petitioner respectfully requests that rejection of Claims 3 and 4 be accordingly withdrawn.

The Petitioner acknowledges that the Examiner has rejected Claims 5 and 6 as being unpatentable under 35 USC § 103 (a) on the grounds of obviousness by Marsh (747,741) in view of Fernandez (5,405,587) and in further view of Mueller, et al (4,432,112), however notes that these rejections rest with the structure of the claimed invention and not the structure disclosed in the subject application. The Petitioner denies that Marsh in view of Fernandez

teaches the limitations of Claims 1 - 4, as the upper panel in Marsh cannot achieve the perpendicular arrangement stated in Claim 2 without obviating the function of Marsh. This point is not remedied by the incorporation an inner shelf based on Fernandez, wherein the product of these elements fails to substantially equate to the instant invention of Claims 5 and 6. It is not well defined how the combination proposed with Mueller presents a nexus to the claimed invention, as the light is mounted in a stationary cabinet wherein its principle purpose is to serve to attract customers, at best only vague instances can be drawn to related utility and in essence do not support the rejection. The proposed combination in view of Mueller regarding an illumination means is demonstrative of the lack of motivation to combine these references by one of ordinary skill in the cosmetology arts. Further, this exercise in combining these references is impermissible as it fails to give proper weight to the distinct advantages, properties and utilities flowing from the invention as a whole, *in re Chupp*, 816 F.2d 643, 2 USPQ2d 1437 (Fed. Cir. 1987). It is essential to consider *all* elements of the claimed invention; it is impermissible to compare the prior art with what the viewer interprets the "gist" of the invention to be., *in re Vas-Cath Inc. v Mahurkar*, 935 F.2d 1555, 19 USPQ2d 1111 (Fed. Cir. 1991). The Petitioner respectfully requests that rejection of Claims 5 and 6 be accordingly withdrawn.

The Petitioner acknowledges that the Examiner has rejected Claim 4 as being unpatentable under 35 USC § 103 (a) on the grounds of obviousness by Marsh (747,741) in view of Fernandez (5,405,587) and in further view of Mueller, et al (4,432,112), however notes that these rejections rest with the structure of the claimed invention and not the structure disclosed in the subject application. The Petitioner denies that Marsh in view of Fernandez teaches the limitations of Claims 1 - 3, as the upper panel in Marsh cannot achieve the perpendicular arrangement stated in Claim 2 without obviating the function of Marsh. As previously discussed in respect to Pullman, the upper panel is incapable of being opened and locked perpendicularly arrangement wherein a working surface is provided, a lower panel is absent and the handle fails to convey the subject matter of Claims 1 and 7. Further, the handle structure in Marsh is distinctly oriented with the front and rear panels not with the left and right side panels as in the present invention. The rejected Claim 4 discloses indentations in the upper and lower panels which distinguish from the holders in Fernandez that are appurtenances that are attached to the panels. There can be little expectation that the combination put forth by these references would successfully represent the function presented in the instant invention, *in re Clinton*, 527 F.2d 1226, 1228, 188 USPQ 365, 367 (CCPA 1976). The Petitioner respectfully requests the rejection to Claim 4 to be accordingly withdrawn.

The Petitioner acknowledges that the Examiner has rejected Claims 5 - 7 as being unpatentable under 35 USC § 103 (a) on the grounds of obviousness by Marsh (747,741) in view of Fernandez (5,405,587) and in further view of Mueller, et al (4,432,112), however notes that these rejections rest with the structure of the claimed invention and not the structure disclosed in the subject application. The Petitioner denies that Marsh in view of Fernandez teaches the limitations of Claims 1 - 4, as the upper panel in Marsh cannot achieve the perpendicular arrangement stated in Claim 2 without obviating the function of Marsh. As previously discussed in respect to Pullman, the upper panel is incapable of being opened and locked perpendicularly arrangement wherein a working surface is provided, a lower panel is absent and the handle fails to convey the subject matter of Claims 1 and 7. The combination with Marsh does not redress this point as the upper lid as in Pullman locks in a vertical manner and does not present a perpendicular arrangement upon opening and locking the upper lid. The proposed combination in view of Mueller regarding an illumination means is demonstrative of the lack of motivation to combine these references by one of ordinary skill in the cosmetology arts. Further, this exercise in combining these references is impermissible as it fails to give proper weight to the distinct advantages, properties and utilities flowing from the invention as a whole, *in re Chupp*, 816 F.2d 643, 2 USPQ2d 1437 (Fed. Cir. 1987). It is essential to consider all elements of the claimed invention; it is impermissible to compare the prior art with what the viewer interprets the "gist" of the invention to be., *in re Vas-Cath Inc. v Mahurkar*, 935 F.2d 1555, 19 USPQ2d 1111 (Fed. Cir. 1991). The Petitioner respectfully requests that rejection of Claims 5 - 7 be accordingly withdrawn.

AMMENDENTS TO THE SPECIFICATION

The Petitioner respectfully requests the following amendment to the specification be entered to restate the claim to priority in accordance with commonly accepted terminology of 35 USC 119. The Petitioner respectfully requests the cross reference to associated applications be amended to reflect commonly accepted terminology. No new claim to priority or new matter is introduced by this amendment. The Petitioner has provided a clean sheet of specification in addition to that showing the revisions.

AMMENDENTS TO THE CLAIMS

The Petitioner respectfully requests the following amendments to the claims be entered in accordance with 37 CFR § 1.121. No new matter is introduced by way of these amendments. The Petitioner has provided a clean sheet of claims in addition to that showing the revisions.

AMMENDENTS TO THE DRAWINGS

The Petitioner respectfully requests the following amendments to the claims be entered in accordance with 37 CFR § 1.121.

REMARKS

This request for correction is respectfully put forth merely to acknowledge acceptance of the Examiner's Amendment of the instant application and extinguish further prosecution of this matter. No new matter is presented to either the specification and/or claims as a function of this amendment. This amendment is not in response to nor does it seek to avoid prior art, or present a new scope of search for the examiner. Acknowledgement of the Examiner's Amendment is respectfully requested.

Respectfully Submitted,

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